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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/382,426	08/24/1999	JEFFRY JOVAN PHILYAW	PHLY-24.732	5220

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EXAMINER

BROWN, TIMOTHY M

ART UNIT	PAPER NUMBER
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2165

DATE MAILED: 03/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

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# Office Action Summary

Application No.

09/382,426

Applicant(s)

PHILYAW ET AL.

Examiner

Timothy M. Brown

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 24 August 1999.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☒ Claim(s) 4 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4 and 6. 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. Claims 1-26 have been examined.

#### *Information Disclosure Statement*

2. The examiner was unable to locate the non-patent literature that has been lined through on the Information Disclosure Statement received October 6, 2000. Therefore, the examiner respectfully requests that the applicant submit these documents should the applicant wish to have them considered.

#### ✓ *Claim Objections*

3. Claim 4 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Line 1 of Claim 4 states that it depends on "[t]he method of claim 4 . . . ." Therefore, claim 4 does not further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

#### ✓ *Claim Rejections - 35 USC § 112*

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 24 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 24 recites the limitation "said unique bar codes . . ." (emphasis added) in the second line of the claim. Claim 24 lacks sufficient antecedent basis for both a

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plurality of bar code and unique bar codes. Furthermore, the second line of claim 24 recites "said unique ID numbers." There is insufficient antecedent basis for "unique ID numbers" in the claim.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 1-6, 13-19 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reber et al. (US 5,930,767).**

Regarding claims 1 and 14, Reber et al. teach a method and system for conducting an on-line transaction wherein the system provides the method comprising the steps of: entering profile information of a user into a computer at a user location disposed on a network (col. 1, lines 36-45); issuing a bar code in response to the user transmitting the profile information from the user location to a second location, the second location disposed on the network (col. 2, lines 24-30; and col. 4, lines 14-27); providing the bar code for purchase of a product of a vendor location disposed on the network, during the on-line transaction (col. 2, lines 24-30; col. 3, lines 57-59; and col. 5, lines 4-15); providing the profile information from the second location to the vendor location in response to the vendor location processing the bar code (col. 5, lines 4-32); and automatically inserting the profile information into a vendor payment form for presentation to the user (col. 10, lines 44-49).

Reber et al. do not specifically teach having the user enter profile information into a form. However, the examiner takes Official Notice that using a form to collect user information over the Internet was notoriously well-known in the Internet commerce art at the time of the applicant's invention. Therefore, it would have been obvious to one having ordinary skill in the Internet commerce art, to combine the teachings of Reber et al., to include the use of a form in order to provide a formatted questionnaire that is directed at obtaining specific information.

Regarding claims 2 and 5, Reber et al. further teach a method and system wherein the user fills in the form only one time (col. 1, lines 36-45).

Regarding claims 3 and 16, Reber et al. teach all the limitations discussed under claims 1 and 14 above. Reber et al. also teach a method and system wherein the user profile information is transmitted to the second location over a public switched telephone network. Reber et al. et al. do not specifically teach the use of a form for transmitting the user profile information. However, the examiner takes Official Notice that, at the time of the applicant's invention, the use of a form was well-known in the Internet Commerce art as discussed under claims 1 and 14 above.

Regarding claims 4 and 17, Reber et al. further teach a method and system wherein the vendor location receives the profile information from the second location in response to the vendor location transmitting the bar code to the second location (col. 5, lines 4-32).

Regarding claims 5 and 18, Reber et al. further teach a method and system wherein the bar code is unique and has a unique ID number associated therewith (col. 1, lines 36-45; col. 2, lines 24-32; and col. 4, lines 14-20).

Regarding claims 6 and 19, Reber et al. further teach a method and system wherein the user provides the unique ID number to the vendor location for payment purposes (col. 1, lines 36-45).

Regarding claims 13 and 26, Reber et al. further teach a method and system wherein the bar code is placed on a credit card (col. 6, lines 41-67; col. 7, lines 1-18; and Fig. 2).

**7. Claims 7-9 and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reber et al. (US 5,930,767) in view of Wong et al. (US 5,956,699).**

Regarding claims 7 and 20, Reber et al. teach all the limitations discussed under claims 1 and 14 above. Reber et al. do not specifically teach a method or system wherein automatically inserting the profile information into a vendor payment form causes all the profile information to be entered as encoded information. However, Wong et al. teach having a user encrypt his personal information, including name, address, telephone and credit card numbers before transmitting them through the Internet (col. 3, lines 38-62). Therefore, at the time of the applicant's invention, it would have been obvious to one having ordinary skill in the Internet Commerce art, to modify the teachings of Reber et al. to include the use or encryption as taught by Wong et al., in order to prevent the unauthorized use of the user's personal information.

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Regarding claims 8 and 21, Reber et al. teach all the limitations discussed under claims 1 and 14 above. Reber et al. do not specifically teach a method or system wherein automatically inserting the profile information into a vendor payment form causes only a portion of the profile information to be entered into the vendor payment form as encoded information. However, Wong et al. teach that a user may encrypt only his vital personal information (col. 3, lines 38-62). Therefore, at the time of the applicant's invention, it would have been obvious to one having ordinary skill in the Internet Commerce art, to modify the teachings of Reber et al. to include the teachings of Wong et al. because limiting the use of encryption would decrease the amount of processing required to decode the user's profile information. Consequently, limiting the use of encryption would decrease the overall time required to process the user's profile information.

Regarding claims 9 and 22, Reber et al. teach all the limitations discussed under claims 8 and 20 above. Reber et al. do not specifically teach a method or system wherein the portion of encoded profile information is credit information. However, Wong et al. teach that a user may elect to encrypt his credit card number (col. 3, lines 38-62). Therefore, at the time of the applicant's invention, it would have been obvious to one of ordinary skill in the Internet commerce art, to modify the teachings of Reber et al. to include the teachings of Wong et al. because encrypting only the user's credit information would limit the amount of processing required to decode the user's profile information. Thus, by reducing the amount of processing required to decode the user's

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profile information, the overall time required to process the user's profile information is reduced.

**8. Claims 10 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reber et al. (US 5,930,767) in view of Green et al. (US 5,664,110).**

Reber et al. teach all the limitations discussed under claims 1 and 14 above. Reber et al. do not specifically teach a method or system wherein the user profile information comprises name, address, ship-to address and credit information. However, Green et al. teach providing a remote vendor with the user's name, address, account information, delivery preference and consumer profile information (col. 5, lines 22-42). Therefore, at the time of the applicant's invention, it would have been obvious to one having ordinary skill in the Internet commerce art, to modify the teachings of Reber et al., to include the teachings of Green et al. because providing a remote vendor with the user's name, address, account information, delivery preference and consumer profile information would eliminate the need for the user to submit this information every time he placed an order with the vendor. This would be particularly advantageous in cases where the user submits multiple orders to the vendor.

**9. Claims 11, 12, 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reber et al. (US 5,930,767) in view of Gardenswartz et al. (US 6,055,573).**

Regarding claims 11 and 24, Reber et al. teach all the limitations discussed under claims 1 and 14 above. Reber et al. inherently teach a database of profile information associated with unique bar codes. Reber et al. disclose that a user is



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identified by having the system read a unique bar code (col. 3, lines 56-67; and col. 4, lines 1-4). The system in Reber et al. must store identifying information that is associated with the unique bar code in order for a user to be identified by bar code. Therefore, a database of profile information associated with unique bar codes is inherent to the teachings of Reber et al.

Further regarding claims 11 and 24, Reber et al. do not specifically teach a method or system wherein the second location is a central registration server having a database of profile information associated with respective unique bar codes and unique ID numbers. However, Gardenswartz et al. teach a remotely-located registration server programmed to receive, store and/or transmit various types of information, including identifying information (col. 6, lines 54-62; and Fig. 1). The database is inherent to the teachings of Gardenswartz et al. because the registration server is programmed for the storage of information (Id.). At the time of the applicant's invention, it would have been obvious to one having ordinary skill in the Internet Commerce art, to modify the teachings of Reber et al. to include the teachings of Gardenswartz et al. because the addition of a central registration server that is capable of storing and transmitting identifying information would provide a system wherein the user could provide his profile information to a number of vendors while submitting this information to the registration server only once.

Regarding claims 12 and 25, Reber et al. teach all the limitations discussed under claims 11 and 24 above. Reber et al. do not specifically teach a method or system wherein the second location is a credit card company server. However, the

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examiner takes Official Notice that, at the time of the applicant's invention, submitting a user's profile information to a credit card company server was notoriously well-known in the Internet commerce art. Therefore, at the time of the applicant's invention, it would have been obvious to one having ordinary skill in the Internet commerce art, to modify the teachings of Reber et al. to include submitting a user's profile information to a credit card company server because this would allow the user to electronically apply for a credit card.

### ***Conclusion***

10. The following prior art made not been relied upon in this action is considered pertinent to applicant's disclosure and is hereby made of record:

- a. Humble (US 4,833,308) 23 May 1989; Checkout counter product promotion system and method
- b. Lebrun et al. (US 5191525) 2 March 1993; System and method for extraction of data from documents for subsequent processing
- c. Russel et al. (US 5,905,248) 18 May 1999; System and method for carrying out information-related transactions using web documents embodying transaction enabling applets automatically launched and executed in response to reading URL-encoded symbols pointing thereto
- d. Merriman et al. (US 5,948,061) 7 September 1999; Method of delivery, targeting, and measuring advertising over networks
- e. Hartman et al. (US 5,960,411) 28 September 1999; Method and system for placing a purchase order via a communications network

- f. Cragun et al. (US 5,971,277) 26 October 1999; Mechanism for retrieving information using data encoded on an object
- g. Wilz et al. (US 5,992,752) 30 November 1999; Internet-based system for enabling information-related transactions over the internet using Java-enabled internet terminals provided with bar code symbol readers for reading Java-Applet encoded bar code symbols
- h. Reber et al. (US 5,995,105) 30 November 1999; Methods and systems for providing a resource in an electronic network
- i. Steger (US 5,925,865) 20 July 1999; Automated check verification and tracking system
- j. Saxe (US 5,636,346) 3 June 1997; Method and system for selectively targeting advertisements and programming
- k. Murphy et al. (US 4,672,377) 9 June 1987; Check authorization system
- l. Samples (US 5,729,002) 17 March 1998; Electronic bar encoded gasoline scanner device
- m. Savino et al. (US 6,015,167) 18 January 2000; System and method of employing a single bar code for coordinating shipping and receiving information
- n. Powell (US 5,806,044) 8 September 1998; System and method for distributing coupons through a system of computer networks
- o. Reber et al. (US 5,986,651) 16 November 1999; Method, system, and article of manufacture for producing a network navigation device

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- p. Kepecs (US 6,330,543) 11 December 2001; Method and system for distributing and reconciling electronic promotions
- q. Veeneman et al. (US 5,754,981) 19 May 1998; Gift registry apparatus and method
- r. Scroggie et al. (US 6,014,634); 11 January 2000; System and method for providing shopping aids and incentives to customers through a computer network
- s. Harms et al. (US 6,070,147) 30 May 2000; Customer identification and marketing analysis systems
- t. Nethery (US 6,070,798) 6 June 2000; Purchaser generated transaction recording and negotiable instrument payment system
- u. Neely (US 6,044,362) 28 March 2000; Electronic invoicing and payment system
- v. Bernard et al. (US 5,918,213) 29 June 1999; System and method for automated remote previewing and purchasing of music, video, software, and other multimedia products
- w. *Newspaper Subscribers Use Symbol Bar-Code Pen Scanner to Capture Web Site Addresses Directly From Print Media, Business Wire* (December 21, 1998)
- x. *BELL ATLANTIC INTRODUCES HOME MANAGEMENT SERVICES IN WASHINGTON AREA, PR Newswire* (January 6, 1993)

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy M. Brown whose telephone number is (703) 305-1912. The examiner can normally be reached on Monday - Friday, 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on (703) 308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Timothy M. Brown  
Examiner  
Art Unit 2165

TMB  
March 8, 2002

  
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